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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/751,269

Applicant(s)

RHOADS ET AL.

Examiner

FARHAN M. SYED

Art Unit

2165

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-14 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-14 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 2-27, filed 20 September 2010, are pending. The Examiner acknowledges cancelled claims 1, 15-21, and 27. No claims were amended or newly added.

Response to Remarks/Argument

2. The Declaration under 37 CFR 1.132 filed 20 September 2010 is insufficient to overcome the rejection of claims 2-14 and 22-26 based upon 35 U.S.C. 103 as set forth in the last Office action because:

(1) Because an attempt is made to address the long-felt need for the solution, reference to commercial success is improper as the Applicant additionally fails to provide any additional reference for it. See MPEP 716.03.;

(2) The Applicant fails to provide concrete dates in the timeline provided. For example, on page 3, Applicant quotes Mr. Libby attempted to approach the knowledge management 15 years ago. What date is it referenced from? When did Baker Donelson have success in rolling out West km, per page 3, etc.; and

(3) The Applicant is requested to provide a timeline with dates to establish the long-felt need, as according to MPEP, 716.04, which states in part ..."Long-felt need is analyzed as of the date of the problem is identified and articulated and there is evidence of efforts to solve that problem, not as of the date of the most pertinent prior art references...".

3. The Examiner attempted to contact Mr. Brian Pollack (Reg. No. 47,001) to attempt to demonstrate the West km, but was unable to coordinate a date and time.
4. The Applicant cancelled claims 27, therefore rendering the 35 U.S.C. §102 rejection moot.
5. The Applicant did not present any additional arguments with respect to the claims rejection under 35 U.S.C. §103(a), aside from the declaration filed supra.

Claim Objections

6. Claims 10 and 13 are objected to because of the following informalities:
As per claim 10, in line 1, between the words 'comprising' and 'providing' a colon (':') is missing, demarking the pre-amble of the claim.
As per claim 13, in line 2, after the word 'service,' a colon (':') is missing, demarking the pre-amble of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-14 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (U.S. Patent No. 5,991,751 and known hereinafter as Rivette)(previously presented) in view of Barney et al (U.S. 6,556,992 and known hereinafter as Barney)(previously presented) and in further view of Houben et al (U.S. 2002/0147745, published 10 October 2002).

As per claim 2, Rivette teaches a system, wherein the first and second databases are separated by a firewall (i.e. "The security module 402 performs the steps of flowchart 11002 to determine whether a user who is requesting an operation involving a data item has sufficient security access privileges with respect to that data item. Preferably, all operations performed by the enterprise server 314 are security checked. In other embodiments, only some operations performed by the enterprise server 314 are security checked. For example, operations involving reading patent documents are not security checked in some embodiments because patents are widely available public documents.")(Column 82, lines 1-10).

As per claim 3, Rivette teaches a system: wherein the work product documents include briefs, client correspondence, advisory opinions, or legal memoranda produced by the law firm (i.e. "Each of the groups comprises any number of patents from the first databases.")(Column 3, lines 64-66); and wherein the second databases are part of an online pay-for-access legal research service (i.e. "The present invention, upon receiving appropriate operator commands, automatically processes the patents in one or more of the groups in conjunction with non-patent information from the second databases.")(Column 3, lines 66-67; column 4, lines 1-2).

As per claim 4, Rivette teaches a system, wherein the means for receiving a query includes a graphical user interface for displaying a taxonomy of selectable legal topics, with selection of one or more of the legal topics indicative of a query being received (i.e. "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710 supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical user interface GUI 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57.")(Column 26, lines 60-67).

As per claim 5, Rivette teaches a system: wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902.")(Column 28, lines 28-31); and wherein the system further comprises means for displaying at least a portion of the documents found by the means for searching, with each displayed portion associated with an indicator of whether the document is a work-product document of the law firm and with a depth-of-treatment indicator indicating a degree of treatment of the legal case within the document (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the patent bibliographic information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's patent repository), only the patents in the current group, or only the current patent. Other embodiments may restrict searching to specific types of documents or specific predefined groups,

such as all European patents, all PCT applications, all non-patent documents, documents in BOM groups, etc.")(Column 28, lines 13-28).

As per claim 6, Rivette teaches a system, wherein each displayed portion associated with an indicator that indicates the document is a work-product document is further associated with information identifying an author of the document, an office location of the author, and an identification of documents within a document management system for the law firm (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the patent bibliographic information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's patent repository), only the patents in the current group, or only the current patent. Other embodiments may restrict searching to specific types of documents or specific predefined groups, such as all European patents, all PCT applications, all non-patent documents, documents in BOM groups, etc.")(Column 28, lines 13-28).

As per claim 7, Rivette teaches a system, wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902.")(Column 28, lines 28-31); and wherein the system further comprises means for displaying at least a portion of each document found by the means for searching, with each displayed portion associated with: a selectively displayable table of authorities

listing documents cited within the document; a selectively displayable listing of other documents citing the document (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11); a selectively displayable listing of work-product documents citing the document (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11).

As per claim 8, Rivette teaches a system, wherein each listed document is associated with a depth-of-treatment indicator indicating a quantitative and/or qualitative degree to which the listed document treats the legal case and one or more of the listed work-product documents are associated with a feedback indicator selectable to view one or more user comments on the one or more listed work-product documents (i.e. "A

user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11).

As per claim 9, Rivette teaches a system, wherein each portion of the documents found by the means for searching includes a selection device for invoking display of text of the document, with text including one or more selectable citations to other corresponding documents and with each citation associated with an indicator of current reliability of its corresponding document as a legal authority (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11).

As per claims 10, 12-14, Rivette teaches a system comprising providing an interface (see Figure 11, item 1124, "display unit" and Figure 8, item 304, which describes a web client. The Examiner interprets the display unit to be the requisite interface and displaying search results are provided through the web client which displays such results)(See Figures 8 and 11) for an online legal research service, wherein the interface enables an authorized law firm user to view search results (i.e. " Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314. In other words, the query request 908A conforms to the enterprise server API.")(Column 28, lines 28-35) including both internal law-firm content including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and content of the online legal research service, wherein the search results are based on a single query submitted or initiated through the interface by the user (i.e. "The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant to search requests from the clients 304, 306." "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710 supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical user interface (GUI) 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57.")(Column 25, lines 39-42; column 26, lines 60-67).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Rivette to include the first database being a part of an information management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the

second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories with the motivation to improve management and leveraging of accumulated knowledge within law-firm document collections.

As per claim 11, Rivette teaches the method wherein the law-firm content is stored in a law-firm information management system (see item 302, Figure 3) that includes a document management system (i.e. document databases)(see Figure 6) for the law firm (i.e. user)(Figure 2) and is separated from the online legal service by a firewall (i.e. Network)(Figure 3).

As per claim 22, Rivette teaches a computer system comprising:

means for receiving a query from an agent of a law firm (i.e. " Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314. In other words, the query request 908A conforms to the enterprise server API."(Column 28, lines 28-35);

means, responsive to the received query (i.e. "The searching module 410 in the enterprise server 314 receives the query request 908A."(Column 29, lines 52-54), for searching at least first and second physical or logical databases (i.e. see Figure 5 for illustration that establishes a relationship between servers and databases. The Examiner interprets servers and databases to be at least more than one server and database, thereby reasonably anticipating the a relationship between the first and second server)(Figure 5) for content related to the query (i.e. " The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct

searches through the data in the databases 316 pursuant to search requests from the clients 304, 306."(Column 25, lines 39-42), **with the first database** (see Figure 4 that describes server configuration for at least one database that includes document storage and retrieval module, whereby the first database is illustrated as at least one database. Item 314 is interpreted as an information management system.)(See Figure 4) including:

Rivette does not explicitly teach a set of work-product documents of the law firm generated by retrieving documents selected from a third database containing work product documents, wherein the retrieved work product documents are converted into a markup language and subsequently indexed based on citations and text to permit the work product documents to be searched by the searching means; and the second database including non-work product documents of the law firm.

Barney teaches a set of work-product documents of the law firm generated by retrieving documents selected from a database (i.e. "a database") (column 11, lines 1-67) containing work product documents (i.e. *"Such information might include prior art that was not cited in the patent, possible license terms, potential problems with the written description or claims of the patent, information about the inventors, information relating to sales of patented products prior to the filing date, legal opinions, related litigation, and any other information that might be relevant to the patent."*)(column 11, lines 1-67); and

the second database (i.e. "a second database") (column 11, lines 1-67) including non-work product documents of the law firm (i.e. *"Examples of indirect patent metrics include reported patent litigation results, published case opinions, patent licenses, marking of patented products, and the like."*) (column 11, lines 1-67).

Rivette is directed to tools for data processing and more particularly related to tools for patent-centric and group-oriented data processing within the legal field. Barney is directed to providing information to patent valuation experts, lawyers, etc. in by rating patent documents and therefore are analogous art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Rivette with the teachings of Barney to include a set of work-product documents of the law firm generated by retrieving documents selected from a database containing work product documents; and the second database including non-work product documents of the law firm with the motivation to improve management and leveraging of accumulated knowledge within law-firm document collections.

The combination of Rivette and Barney do not teach a third database and wherein the retrieved work product documents are converted into a markup language and subsequently indexed based on citations and text to permit the work product documents to be searched by the searching means.

Houben teaches a third database (i.e. internet database)(see Figure 1; see also paragraph [0042]) and wherein the retrieved work product documents (i.e. legacy data)(paragraph [0052]) are converted into a markup language (i.e. "...converts legacy data into XML document.")(paragraph [0052]) and subsequently indexed based on citations and text to permit the work product documents to be searched by the searching means (The Examiner notes that this limitation is an intended use of leveraging XML language that uses document-type-definition (DTD) that facilitates the XML document to be indexed and searched.. In addition, these documents are parsed into memory creating a tree structure (i.e. indexed).).

Rivettes is directed to patent-centric data that comprises at least of documents stored in a database. Houben is directed to converting incoming documents into markup language document and therefore are analogous art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the combined teachings of Rivette and Barney with the teachings of Houben to include a third database and wherein the retrieved work product documents are converted into a markup language and subsequently indexed based on citations and text to permit the work product documents to be searched by the searching means with the motivation to convert legacy data into a form cognizable by Internet based system (Houben, paragraph [0003]).

As per claim 23, the combination of Rivettes, Barney, and Houben teaches the system, wherein the retrieving step is accomplished by automatically migrating or mirroring documents selected from the third database to the first database (i.e. Figure 3 illustrates a retrieving step that automatically migrates documents selected from the third server to the first server)(Houben, Figure 3).

As per claim 24, the combination of Rivettes, Barney, and Houben teaches the system, wherein the migration process includes retrieving at least one work product document from the third database by using administrator defined queries and executing those queries on a scheduled basis or event-driven basis (Figure 8 illustrates an event or schedule driven query that retrieves at least one work product.)(Houben, Figure 8).

As per claim 25, the combination of Rivettes, Barney, and Houben teaches the system wherein the migration process further includes:

- (i) storing citation relationships (i.e. XSLT is leveraged to store citation relationships)(Houben, paragraph [0054]);
- (ii) storing the work product documents with tagged citations (i.e. XML structures or tags are associated to an XML document)(Houben, paragraph [0014]); and
- (iii) storing document profile data in the first database (i.e. Business server, Figure 1, Item 1096, stores document profile data)(Houben, Figure 1).

As per claim 26, the combination of Rivettes, Barney, and Houben teaches the system, wherein at least a portion of the metadata profile data of the work product documents are incorporated into the converted work product documents on the first database (Houben, see paragraphs [0049-0053]).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farhan M. Syed whose telephone number is 571-272-7191. The examiner can normally be reached on 8:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Neveen Abel-Jalil can be reached on 571-272-4074. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Neveen Abel-Jalil/

Supervisory Patent Examiner, Art Unit 2165